



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| | | | | |
|--|-------------|----------------------|-----------------------------|------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/852,119 | 05/09/2001 | Ronald A. Braco | 7198 | 4159 |
| 22922 7590 04/18/2007 REINHART BOERNER VAN DEUREN S.C. ATTN: LINDA KASULKE, DOCKET COORDINATOR 1000 NORTH WATER STREET SUITE 2100 MILWAUKEE, WI 53202 | | | EXAMINER OYEIBISI, OJO O | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3692 | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 04/18/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/852,119

Applicant(s)

BRACO, RONALD A.

Examiner

OJO O. OYEBISI

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 31-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/29/2007 has been entered. In the RCE filed on 01/29/2007, the following have occurred: Claims 1, 17, and 25 have been amended, and claims 1-26 and 31-34 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-21, 24-26, 31-32, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolling et al (Koll hereinafter US PAT: 5,963,925).

Re claim 1. Koll discloses a switching system for electronic presentment and payment of bills over a network, comprising: a first consumer service provider device which is in electronic communication with a first consumer terminal, a first

Art Unit: 3692

bill service provider device which is in electronic communication with a first biller terminal, a second consumer terminal; a second biller terminal; and a switching network for which is in electronic communication with said first consumer service provider device using one of a first message standard protocol and a second message standard protocol, with said first bill service provider device using one said first and second message standard protocols, with said second consumer terminal using one of said first and second message standard protocols, and with said second biller terminal using one of said first and second message standard protocols (see fig. 1 and fig. 2); routing presentment information between said first consumer service provider or said second consumer terminal and said first bill service provider or said second biller terminal, said switching network being a multi-standard switch configured to facilitate electronic communication between said first consumer service provider or said second consumer terminal and said first bill service provider and said second biller terminal irrespective of which message standard protocol each of said first consumer service provider, said first bill service provider, said second consumer terminal, and said second biller terminal use (see col. 9, lines 1-24) (see abstract).

Re claim 2. Koll further discloses a switching system, wherein said switching network routes information between said consumer service provider or said second consumer terminal and said bill service provider or said second biller terminal without reformatting (see col. 10, lines 55 – 65, also see col. 13, lines 35-

Art Unit: 3692

45 – a biller may supply a variety of templates each suitable for handling a different data standard that would enable a CFI to present electronic statement a variety of forms to its customers).

Re claim 3. Koll further discloses a switching system, further comprising a second consumer service provider device which is in electronic communication with a third consumer terminal (see fig.1 and fig.2), said switching network being in electronic communication with said second consumer service provider device using a different one of said first and second message standard protocols than the one of said first and second message protocols which is used between said first consumer service provider and said switching network (i.e., as system 200 may accommodate any number of billers, during any given time period switch 214 is receiving batches of statement data from any number of billers (and any number of SORGs) and routing the statement data to any number of appropriate SGENs 222. In other words, a batch of statement data from one biller may be distributed to any number of SGENs each located in a different CFI, see col.10 lines55-65, also see CFI can deliver electronic statement to consumers using the consumer's medium of choice, col.9 lines 1-14).

Re claim 4. Koll further discloses a switching system, further comprising a consumer payment provider (i.e., CFI, fig.2, element 132) device in electronic communication between said first consumer service provider device and said switching network (see fig.2, also see col.4, line 63 through col.5, line 30).

Re claims 5 . Koll further discloses a switching system, further comprising a

Art Unit: 3692

second biller service provider device in electronic communication with a third consumer terminal (see fig.2, also see col.4, line 63 through col.5, line 30) said switching network being in electronic communication with said second consumer service provider device using a different one of said first and second message standard protocols than the one of said first and second message protocols which is used between said first consumer service provider and said switching network (i.e., as system 200 may accommodate any number of billers, during any given time period switch 214 is receiving batches of statement data from any number of billers (and any number of SORGs) and routing the statement data to any number of appropriate SGENs 222. In other words, a batch of statement data from one biller may be distributed to any number of SGENs each located in a different CFI, see col.10 lines55-65, also see CFI can deliver electronic statement to consumers using the consumer's medium of choice, col.9 lines 1-14).

Re claim 6. Koll further discloses a switching system, further comprising a biller payment provider (i.e., BFI, fig.2, element 108) device in electronic communication between said first consumer service provider device and said switching network (see fig.2).

Re claim 7. Koll further discloses a switching system, further comprising a payee terminal (i.e., BSP fig.2, since biller's provider can also serve as a payee, see col.7, lines40-50, also see fig.12) in electronic communication with said biller payment provider device (i.e., BFI fig.2, element 108) (see fig.2).

Art Unit: 3692

Re claim 8. Koll further discloses a switching further comprising an associated memory device in which a directory of said first consumer service provider device, said first bill service provider device, said second consumer terminal, and said second biller terminal is stored (see col.33 lines 40-67), wherein said first consumer service provider device, said first bill service provider device, said second consumer terminal, and said second biller terminal must each be registered in said directory in order to access said switching network (see fig.6a element 504, fig.8 element 700)

Re claim 9. Koll further discloses a switching system for electronic presentment and payment of bills over a network, comprising: a consumer terminal; a biller terminal; and a switching network which is electronic communication with said consumer terminal (see fig.1 and fig.2, also see the abstract) using one of a first message standard protocol and a second message standard protocol and with said biller terminal using one of said first and second message protocols, exchanging billing information between said consumer terminal and said biller, terminal irrespective of which message protocol each of said consumer terminal and said biller terminal use (i.e., as system 200 may accommodate any number of billers; during any given time period switch 214 is receiving batches of statement data from any number of billers (and any number of SORGs) and routing the statement data to any number of appropriate SGENs 222. In other words, a batch of statement data from one biller may be distributed to any number of SGENs each located in a different CFI, see col.10 lines 55-65, also

see CFI can deliver electronic statement to consumers using the consumer's medium of choice, col.9 lines 1-14), said switching network routing bill summary data generated by a biller terminal for presentment at said consumer terminal (i.e., kolls can display summary invoice as well as the whole invoice in any format chosen by the consumers, see col.31, lines 57-67), complete bill data being accessible only by direct communication between the consumer terminal and said biller terminal (see fig.2 and fig.3, also see col.9, lines 1-24).

Re claim 10. Claim 10 recites similar limitations to claim 2, and thus rejected using the same art and rationale in the rejection of claim 2.

Re claim 11. Claim 11 recites similar limitations to claim 3, and thus rejected using the same art and rationale in the rejection of claim 3.

Re claim 12. Claim 12 recites similar limitations to claim 4, and thus rejected using the same art and rationale in the rejection of claim 4.

Re claim 13. Claim 13 recites similar limitations to claim 5, and thus rejected using the same art and rationale in the rejection of claim 5.

Re claim 14. Claim 14 recites similar limitations to claim 6, and thus rejected using the same art and rationale in the rejection of claim 6.

Re claim 15. Claim 15 recites similar limitations to claim 7, and thus rejected using the same art and rationale in the rejection of claim 7.

Re claim 16. Claim 16 recites similar limitations to claim 8, and thus rejected using the same art and rationale in the rejection of claim 8.

Re claims 17, 20 and 24. Koll discloses a method for electronic presentment and

Art Unit: 3692

payment of bills over a network, comprising: providing a switching network for facilitating electronic presentment and payment of bills (see abstract); establishing electronic communication between said switching network and first and second biller terminals and first and second consumer terminals (see fig.1 and fig.2), said switching network being a multi-standard switch configured to communicate with said first and second biller terminals and said first and second consumer terminals in either of at least first and second message standard protocols, said switching network communicating with at least one of said first and second biller terminals and said first and second consumer terminals using said first message standard protocol and at least one of said first and second biller terminals and said first and second consumer terminals using said second message protocol (i.e., as system 200 may accommodate any number of billers, during any given time period switch 214 is receiving batches of statement data from any number of billers (and any number of SORGs) and routing the statement data to any number of appropriate SGENs 222. In other words, a batch of statement data from one biller may be distributed to any number of SGENs each located in a different CFI, see col.10 lines55-65, also see CFI can deliver electronic statement to consumers using the consumer's medium of choice, col.9 lines 1-14); generating a bill summary data from complete bill data provided by each of said first and second billing terminals; selectively routing portions of said bill summary data via the switching network to present appropriate portions of said bill summary data to said first and second consumer billing terminals (i.e., kolls can display summary invoice as well as the whole invoice in any format chosen by the consumers, see col.31, lines 57-67) (see abstract).

Art Unit: 3692

Re claim 18. Koll further discloses the method, wherein electronic communication between said switching network and said first consumer terminal is established through a first consumer service provider device, and wherein electronic communication between said switching network and said second consumer terminal is established through a second consumer service provider device(i.e., as system 200 may accommodate any number of billers, during any given time period switch 214 is receiving batches of statement data from any number of billers (and any number of SORGs) and routing the statement data to any number of appropriate SGENs 222. In other words, a batch of statement data from one biller may be distributed to any number of SGENs each located in a different CFI, see col.10 lines55-65, also see CFI can deliver electronic statement to consumers using the consumer's medium of choice, col.9 lines 1-14, also see fig.1 and fig.2).

Re claim 19. Claim 19 recited similar limitations to claim 2, and thus rejected using the art and rationale in the rejection of claim 2.

Re claim 21. Koll further discloses a method, further comprising the steps of, storing a directory of consumer terminals which are registered with said switching network in an associated memory device (see col.33 lines 40-67); generating payment instructions from said first and second consumer terminals; transmitting said payment instructions which are generated by said first and second consumer terminals to the said switching network(see col.13, lines 52-58); verifying that said payment instructions are from consumer terminals which are registered with said switching network, causing said payment instructions to be executed (consumers are presented with a login prompt

(see fig.11), which allows only customers who are registered with the switching network to gain access to the said switching network. Inherently, the payment instructions made by said consumers from the consumer terminals are verified).

Re claim 25. Claim 25 recites similar limitations to claim 1, and thus rejected using the same art and rationale in the rejection of claim 1.

Re claim 26. Koll discloses a system for electronic presentment and payment of bills over a network, comprising: a consumer terminal; a biller terminal in communication with said consumer terminal (see fig.1 and fig.2); and a switching network for routing a payment message for a particular bill between said consumer terminal and biller terminal (see col.9, lines 1-24, also see the abstract) irrespective of whether the particular bill has been previously presented to said consumer terminal (i.e., optional section of the bill are downloaded at the customers request., see col.19, lines 15-20).

Re claim 31. Koll further discloses a switching system, wherein said first message standard protocol comprises the Open Financial Exchange ("OFX") standard protocol and said second message standard protocol comprises the Interactive Financial Exchange ("IFX") standard protocol (see col.33 lines 15-40).

Re claim 32. Koll further discloses a switching system, wherein said switching network routes bill summary data generated by said biller service provider device or by said first or second biller terminals for presentment at said first or second consumer terminals (see abstract) complete bill data being accessible only by direct communications between said first or second consumer terminals and said biller service provider device or said first or second biller terminals (i.e., as system 200 may accommodate any

Art Unit: 3692

number of billers, during any given time period switch 214 is receiving batches of statement data from any number of billers (and any number of SORGs) and routing the statement data to any number of appropriate SGENs 222. In other words, a batch of statement data from one biller may be distributed to any number of SGENs each located in a different CFI, see col.10 lines55-65, also see CFI can deliver electronic statement to consumers using the consumer's medium of choice, col.9 lines 1-14) (see abstract).

Re claim 34. Koll further discloses a switching system, wherein said switching network is arranged and configured to log all presentment and payment communications as they are routed for reporting on a periodic basis (see col.12, lines 20-27).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 22, 23 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koll in view of Hilt et al (Hilt hereinafter U.S PAT 5,465,206).
6. **Re claim 22.** Koll does not explicitly disclose the method, wherein prior to said step of causing said payment instructions to be executed said switching network verifies that a sufficient balance exists in financial account associated with each consumer terminal from which payment instructions are received to cover the bill being paid. Hilt makes this disclosure (see abstract, also see fig.11, element

254). Thus, it would have been obvious to one of ordinary skill in the art to combine Koll and Hilt in order to prevent loss to the biller.

Re claim 23. Koll does not explicitly disclose the method, further comprising the step of settling all payment transactions over a predetermined cut-off period. Hilt makes this disclosure (see abstract, also see fig11). Thus, it would have been obvious to one of ordinary skill in the art to combine Koll and Hilt in order to ensure that billers are properly and timely compensated for the services they provide to the consumers.

Re claim 33. Koll does not explicitly disclose a switching system, wherein said switching network is arranged and configured to provide net settlement functionality by debiting financial accounts associated with consumers associated with said first and second consumer terminals and crediting the financial accounts of billers associated with said first and second biller terminals by appropriate amounts. However, Hilt makes this disclosure (see abstract, also see fig11). Thus, it would have been obvious to one of ordinary skill in the art to combine Koll and Hilt in order to ensure that billers are properly and timely compensated for the services they provide to the consumers.

Response to Arguments

7. Applicant's arguments filed 01/29/07 have been fully considered but they are not persuasive. The applicant argues in substance that the primary reference, Koll, does not disclose, teach, or suggest a multi-standard switching network which is capable of

communicating using a plurality of different message standard protocols. Contrary to the applicant's assertion, Koll explicitly makes this disclosure (i.e., Central site switch 214 may be implemented on any suitable computer. By way of example, an IBM-compatible server running Microsoft Windows NT Server has been found to produce desirable results. In an alternative embodiment, switch 214 is composed of two computers, one computer for switching ESP system data to CFIs, and a second computer for switching electronic bill payments back to billers. The functionality of switch 214 as it relates to ESP system 200 will be herein described; functionality of a comparable central site switch as it relates to electronic bill payments is disclosed in U.S. Pat. No. 5,465,206.

In general, switch 214 serves as a store and forward switch to route all ESP system data between system end points. It also includes a template library 216 for templates produced within system 200 and provides for data archiving, system audits and reconciliation. Switch 214 receives templates 212 from TAWS 210 for storage in template library 216. Switch 214 may then transmit a template 212 to template validation workstation (TVAL) 218 for template validation, transmit a template 212 to SORG 208 to validate statement data, or transmit a template 212 to statement generation workstation (SGEN) 222 for generation of an electronic statement. Based upon biller and consumer identification provided in templates and statement data, switch 214 is able to route templates 212 and statement data 220 to the appropriate SGEN 222 and on to the appropriate CFI 130. As system 200 may accommodate any number of billers, during any given time period switch 214 is receiving batches of statement data from any number of billers (and any number of SORGs) and routing the

statement data to any number of appropriate SGENs 222. In other words, a batch of statement data from one biller may be distributed to any number of SGENs each located in a different CFI, see col.10 lines 32-67).

The applicant further argues that neither Kolling nor Hilt teaches verifying that the payment instructions are from consumer terminals, which are registered with the switching network. Contrary to the applicant's assertion, the examiner maintains that consumers are presented with a login prompt (see fig.11) in Kolling's, which allows only customers who are registered with the switching network to gain access to the said switching network. Inherently, the payment instructions made by said consumers from the consumer terminals are verified.

The applicant further argues that neither Kolling nor Hilt teaches a switching network for routing a payment message for a particular bill between said consumer terminal and biller terminal, irrespective of whether the particular bill has been previously presented to said consumer terminal. Contrary to the applicant's assertion, the examiner maintains that Kolling explicitly makes this disclosure (i.e., switch 214 transmits template 212 to a statement generation workstation (SGEN) 222.

Periodically during a billing cycle, switch 214 routes standard statement data 220 using information contained in the data to SGEN 222. Using template 212 and standard statement data 220, SGEN 222 generates an electronic statement 224 and transmits it to consumer financial institution (CFI) 130. CFI 130 then delivers electronic statement 224 to consumer 140 using the consumer's medium of choice. During operation of ESP system 200, switch 214 receives billing information from a

Art Unit: 3692

universal biller file (UBF) 300 (described in FIG. 4 below) and distributes information needed to entities within the system.

It is true that Koll is an electronic statement presentment system. However, the secondary reference, Hilt, is an electronic bill pay system. Thus Hilt compensates for the incomplete teachings of Koll, and one of ordinary skill in the art would have been motivated to combine Koll and Hilt in order to ensure that billers are properly and timely compensated for the services they provide to the consumers. The Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD E. CHILCOT can be reached on (571)272-6777. The fax phone

Art Unit: 3692

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 4/16/07
JAMES A. KRAMER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600